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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,197	10/02/2000	Mehran Mehregany	47799.00003	7092

7590 10/03/2003

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,197

Applicant(s)

MEHREGANY ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-25 have been examined.

Claim Objections

2. Claim 6 is objected to because of the following informalities: the phrase "on whose behalf the one or more proposals are being solicited." is vague. Appropriate correction is required.
3. Claims 10 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. Claims 1, 3-5, 8, 16, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of how a supplier is "qualified suppliers..." is missing. The use of "qualified suppliers..." phrase make the claims indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in the claims in order to achieve the desired results expressed in the "qualified suppliers..." phrases.
6. Therefore, independent claims 1, 3-5, 8, 16, 17, and 19 are rejected. Additionally dependent claims 2, 6, 9, 10-15, and 18 are rejected based on being dependent on rejected independent claims.
7. The term "potential suppliers..." in claims 1, 7, 9, 10, 11, 12, 13, 14, and 20 is a relative term, which renders the claim indefinite. The use of the term "potential suppliers ..." make the claims indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in the

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claims in order to achieve the desired results expressed in the "potential supplier..." phrase. The use of the term "potential suppliers ..." is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. What does constitute the potentiality of one or more supplier to be "potential suppliers..." is not clear in the claim and the limits or boundaries of such potential selection of one or more supplier is not defined.

8. Therefore, independent claims 1, 7, 9-14, and 20 are rejected. Additionally dependent claims 2-6, 8, 15-19, and 21 are rejected based on being dependent on rejected independent claims.

9. Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of how a buyer is "eliciting information..." is missing the element of what particular "information" is elicited. The use of "eliciting information..." phrase make the claims unclear in that neither means nor interrelationship of means nor method steps are set forth in the claims in order to achieve the desired results expressed in the "eliciting information..." phrases.

10. In addition dependent claims 5 and 6 are rejected based on being dependent on rejected claim 4.

11. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: The term "proposal announcement..." in claim 4 is not defined for whom or what entity the "proposal announcement" is prepared for and how.

12. In addition dependent claims 5 and 6 are rejected based on being dependent on rejected claim 4.

13. Claims 7 recite the phrase "ordering each potential R&D supplier by the number of occurrences" in the context that is not clear to the examiner. It is not clear to the examiner what "ordering..." entails within the claim language. Clarification of this claim and similar claims are requested.

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14. The term "evaluating... the best mix of complementary..." phrase in claim 8 specifically "evaluating" and "best" make the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "evaluating... the best mix of complementary..." phrase. There is no clear step of what are the bases of "evaluating" and what would mean the "best"?

15. The term "knowledge of competition..." phrase in claim 9 specifically "knowledge" make the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "based upon knowledge of competition..." phrase. There is no clear step of what are the bases of "knowledge"?

16. The term "abstract proposal..." phrase in claim 16 specifically "abstract" make the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "evaluating the abstract proposal..." phrase. There is no indication what constitutes "abstract" and what are the bases of how this abstract proposal is evaluated. In addition it is not clear what constitute "fu;; proposals...".

17. The term "assembling a review panel..." phrase in claim 17 specifically "assembling" make the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "assembling a review panel..." phrase. It is not clear how this assembling takes place and what are the criteria of such "assembling".

18. The term "weighted to..." phrase in claims 20 and 22 makes the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "weighted to..." phrase. It is not clear what steps are taken to establish the weight a record and what constitutes the weighting of such an index record.

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19. In addition dependent claims 21, and 23-25 are rejected based on being dependent on rejected claims 20 and 22.

20. The term "particular area..." phrase in claims 21 makes the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "particular area..." phrase. It is not clear what constitutes the particularity of an area, what are the criteria of this particularity within the context of the claim.

21. The term "unique keyword..." phrase in claim 22 makes the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "unique keyword..." phrase. It is not clear what steps are taken to qualify a keyword as "unique" and what constitute "a unique keyword".

22. In addition dependent claims 23-25 are rejected based on being dependent on rejected claim 22.

23. The term "particular area..." phrase in claims 23 makes the claim indefinite and unclear in that neither means nor interrelationship of means nor method steps are set forth in claims in order to achieve the desired results expressed in the "particular area..." phrase. It is not clear what constitutes the particularity of an area, what are the criteria of this particularity within the context of the claim.

Claim Rejections - 35 USC § 101

24. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

25. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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26. The claims as presently claimed and best understood were considered in light of the new "Examination Guidelines for Computer-Related Inventions" and were found to be non-statutory.

Discussion of the analysis of the claims under the guidelines follows.

27. The specification has been reviewed to see if the disclosed invention is in the technological art and that it has a practical use in the art. The review shows that the system uses a computerized method or system to match potential plurality of suppliers of services of R&D with that of requesting parameters by the solicitor/s.

28. It is noted that method claims 1 fail to recite/define a computer, machine or device that would render the claims in the technological arts and in statutory status.

29. Furthermore, as for claim 1, the invention, as defined by the claims and as best understood by the examiner merely manipulate an abstract idea or perform a purely mathematical algorithm without any limitation to a practical application in the technological arts. However, the claimed invention manipulates data representing attributes and conditions, which are abstract and non-limiting. The invention does not require physical acts to be performed outside the computer independent of and following the steps to be performed by the programmed computer, where those acts involve the manipulation of tangible physical objects and results in the object having a different physical attribute or structure. See *Diamond v. Diehr*, 450 US at 187, 209 USPQ at 8. The steps of computer processing data related to attributes and conditions do not impose independent limitations on the scope of the claims beyond those required by the mathematical operation and abstract limitations because the attributes represented by symbols and conditions, which are purely abstract are not actually measured values of physical phenomena. *In re Galnovatch*, 595 F. 2nd at 41 n.7, 201 USPQ at 145 n.7; *In re Sarker*, 588 F.2nd at 1331, 200 USPQ at 135. The steps of "associating" have no direct effect on the physical world outside the computer. Thus, the claimed invention merely associates certain data with certain other data (attributes and conditions) and performs a mathematical algorithm without any limitation to a practical application as a result of the algorithm or outcome and is therefore deemed to be non-statutory.

30. Claims 2-19 are rejected as being dependent claims to above mentioned claim that have been rejected under 35 U.S.C. 101. Same rejection rational is applied for rejecting these claims.

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Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent No. 6,598,026, to Purnedu Shekhar Ojha, Methods and Apparatus for Brokering Transaction.
- U.S. Patent No. 5,924,082, to David L. Silverman, Negotiated Matching System.
- U.S. Patent No. 6,574,608, to Shabbir M. Dahod, Web-Based System for Connecting Buyers and Sellers.
- PCT WO01/71594 A1, to Hong-Lyoul Lee, Method and Apparatus for facilitating Commerce Between Buyer and Seller.

32. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

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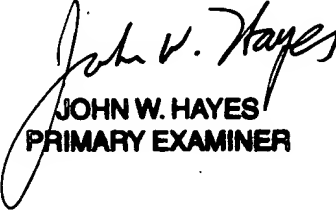
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
September 17, 2003**


**JOHN W. HAYES
PRIMARY EXAMINER**